

REMARKS

The Office Action does not include an action on the merits, and instead is limited to the issuing of a restriction requirement. Applicants hereby (1) provisionally elects to proceed with the claims in Claim Group #1 (claims 1-29); and (2) traverses the restriction requirement.

I. OVERVIEW

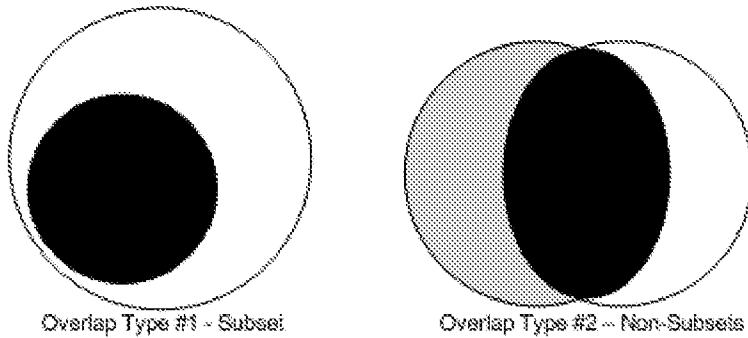
Each of Applicants' claims relate to a single "genus" of an invention that can be implemented in a wide variety of different "species." Each of Applicants' claims includes (1) a particular shaking motion that is consistent across the different claim groups; and (2) a physical structure for implementing the shaking motion that is also consistent across the different claim groups.

Claim 1 includes an "eccentric rotation" limitation. A review of paragraph [0056] in the Specification reveals that the Applicants disclosed that the purpose of an eccentric rotation is "so that substances do not begin to settle in relation to an unchanging center of motion." Other independent claims include similar limitations, although more detailed and specific than the "eccentric motion" limitation.

The chart below indicates that there is substantial overlap between the three claim "groups" with respect to the claimed shaking motion and the corresponding structure.

Claim 23	Claim 30	Claim 39
"a generally vertical axis configured to dynamically tilt "	" tilting of said generally vertical axis"	" tilting said container base with respect to a horizontal surface"
"container base is configured to laterally translate with respect to said generally vertical axis "	" lateral translating of the container with respect to a generally vertical axis "	" laterally moving a container base in substantial accordance with said eccentric rotation of said wheel" (which is "about a substantially vertical axis ")
" container "	" container "	" container "
" wheel configured to spin"	No specific reference to a " wheel " but the functionality of a "lateral translating of the container" is specifically claimed	"rotation of said wheel "
" container base "	No specific reference to a " container base " but the functionality "applying a plurality of motions to the container" is included	" container base "

Page 2 of the Office Action correctly notes that “subcombinations are distinct if they do not **overlap in scope**.” However, contrary to the Office Action, Applicants’ claims do “overlap in scope.” The Office Action incorrectly asserts that Applicants’ claims do no overlap with each other because the Office Action misconstrues what it means to “overlap.” **As indicated by the illustrations below, it is possible for claim A to overlap with claim B without one claim being a subset of the other.**



Even if the Office Action is correct in asserting that Applicants’ claims relate to more than a single invention, there is substantial overlap between the various claims set forth by the Applicants. As provided above, each of the claims includes limitations that relate to a particular shaking motion, as well as to a structure for implementing the shaking motion. With respect to whether the instant restriction requirement is proper, MPEP § 806(C) requires that “[w]here inventions are related as disclosed but are not distinct as claimed, restriction is **never** proper [emphasis added].”

In other words, even if Applicants’ claims pertain to more than a single invention, a restriction is inappropriate because those different inventions are not “distinct as claimed.” A review of the element chart provided above shows that that the claim groups are not “distinct” from each other for the purposes of a restriction requirement.

II. Office Action Section 2

Applicants’ claims are not distinct from each other. As discussed above, there is substantial overlap between the various claim “groups.” With regards as to whether or not it is possible to infringe one claim without infringing another (e.g. “separately usable”) the Applicants respectfully point out that redundant claims are prohibited, and thus different claims are required to be of different scope. This means that it is possible to practice one claim without practicing another.

The citation to MPEP § 806.05(d) is not applicable because that provision of the MPEP is premised on the condition that if “they do **not overlap** in scope and are **not obvious variants** [emphasis added].” With respect to the Applicants’ claims, the claims

do overlap in scope. Moreover, the variants are specifically disclosed in the Specification.

With respect to the example of washing machine, the Applicants point out that conventional washing machines do not include the motion limitations discussed above (eccentric motion, tilting, etc), and thus none of the claim sets would cover a conventional washing machine. Moreover, a conventional washing machine does not involve the shaking of a “container.”

If a washing machine was modified so that it would fall under the scope of claim 23, it is also likely to be covered under claims 30 and 39. Thus, the washing machine example does not illustrate that the claim groups are sufficiently “distinct from each other in the context of a restriction requirement. The fact that none of claim elements appears to include or exclude an attribute that is washing machine specific does not render the claim groups distinct for the purposes of a restriction requirement.

III. Office Action Section 3

The references to washing machines and to ultrasonic wave cleaners do not support the propriety of the restriction requirement. As noted above, conventional washing machines would not infringe due to the motion-based limitations and do not involve the shaking of a “container.” Similarly, conventional ultrasonic wave cleaners would not infringe any of the claim groups because ultrasonic waive cleaners do not shake containers and do not function consistent with the claimed motion-based limitations.

With respect to MPEP § 806.05(e), It is the duty of the Examiner to provide examples of Applicants’ invention for shaking a container that is **materially different** from the Applicants’ invention. MPEP § 806.05(e) provides as follows:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as *claimed* can be practiced by another **materially different** apparatus or by hand; or (B) that the apparatus as *claimed* can be used to practice another * **materially different** process [emphasis added].

If a device or method can be used to shake a container and otherwise fall under the scope of Applicants’ claims, it is the burden of the Examiner to establish that the device or method is **materially different** from the apparatus and/or method claimed by the Applicants.

IV. Office Action Section 4

As provided above, the invention claimed by the Applicants' is a single invention that can be implemented in a variety of different contexts. In the same way that a patent covering a piston ring can be implemented in any vehicle using a combustion engine, the Applicants' shaking technology can also be used in a variety of different contexts. For example, such as device could be used to shake a container of paint or a container of cosmetics. Many issued patents involve more than a single context of potential use and relate to more than a single classification.

Focusing exclusively on Claim Group #1 is not going to reduce the number of applicable classifications. Focusing exclusively on Claim Group #1 is not going to make the task of performing a search and analyzing the results in comparison to the Applicants' claim elements easier to perform except by the mere fact that fewer claims will be examined. A review of the claim element chart provided above reveals that there are substantial overlaps between the various claim groups. In light of that chart, the burden placed on the Examiner does not appear to be significant.

V. Office Action Section 5

Searching exclusively for prior art pertaining to Claim Group #1 will not result in a materially easier burden than a search for Claim Groups #1- #3. There is no reason to believe that focusing exclusively on Claim Group #1 will reduce the field of search. The Office Action fails to disclose which fields of search can be avoided as a result of the restriction requirement.

VI. Office Action Section 6

Applicants' have provisionally elected to proceed with the claims in Claim Group #1 (claims 1-29). Applicants also traverse the restriction requirement.

The specific errors in the restriction requirement are discussed above and summarized in the following list:

1. There is significant overlap between the different claim groups. See the chart provided above.
2. An overlap between two claims is not limited to a relationship where one claim is a subset of another.
3. Claims in Groups II and III are variants/species of the genus set forth in claim 1 (Group I).
4. The Office Action does not address the "materially different" requirement set forth in MPEP § 806.05(e).
5. The Office Action does not set forth a *prima facie* case for the restriction requirement with evidence pertaining to the lack of overlap.

6. No fields of search can be precluded (e.g. the Examiner's burden is not reduced) by ignoring the claims in Groups II and III.
7. Conventional washing machines and/or ultrasonic acoustic wave cleaners would not be covered under any of the pending patent claims.

With respect to the reminder regarding a rejection pursuant to 35 §103(a), it is the position of the Applicants that there is substantial overlap between the various claim groups but that none of the claim groups is redundant or identical with any other claim group. A response traversing the restriction requirement does not inherently mean that the Applicants acknowledge one set of claims is obvious in light of a second set of claims. The requirements for a proper restriction involve more than the single "obvious variant" requirement and an admission with respect to obviousness is not required for the Applicants to traverse the restriction requirement. No such admission is made in this paper.

VII. Office Action Section 7

The election of the claims in claim group 1 does not add or remove inventor status to any individual.

CONCLUSION

The restriction requirement is not proper because there is substantial overlap between the elements in the various claim groups. The elements chart provided above illustrates that the variations between the different claim groups are not substantial enough to constitute "distinct" inventions for the purpose of a restriction requirement.

Dated: October 12, 2006

Respectfully submitted,

Christopher J. Falkowski
By _____
Christopher J. Falkowski, Reg. No. 45,989
Falkowski PLLC
P.O. Box 650
Novi, MI 48376-0650
(248) 894-3796
Attorney for Applicant
Customer No. 53961